

REMARKS

Claims 1-4 and 7-21 are currently pending in the application. By this amendment, claim 1 is amended and claims 11-21 are added for the Examiner's consideration. Claims 5 and 6 are canceled without prejudice or disclaimer. The above amendments do not add new matter to the application and are fully supported by the original disclosure. For example, support for the amendments is provided in the claims as originally filed, at Figure 1, and at pages 1-3 of the specification as originally filed. More particularly, Figure 1 shows an embodiment of the invention comprising an outermost layer of boards (1, 2, 3), an inner layer of boards (1a, 2a, 3a) and a third layer of boards (1b, 2b, 3b). The outermost layer is shown with interspaces (4) filled with insulating material (5). The inner layer and third layer are shown with interspaces (4) devoid of the insulating material (5). Plastic mat (6) is shown between the outermost layer and the inner layer. Nail plate (7) is shown between the inner layer and the third layer. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Objection to Specification

The specification has been objected to. The Examiner asserts that the meaning and scope of the term "MUF" on page 2 is not understood. This objection is respectfully traversed.

Applicants respectfully submit that the acronym "MUF" stands for "melamin-urea-formaldehyde", as is known to those having ordinary skill in the art. The Examiner's attention is directed to, for example, U.S. Pat. No. 6,399,214 (col. 1, lines

30-34) and U.S. Pat. No. 6,458,417 (col. 6, lines 3-6), which clearly shows that the term MUF is known.

Accordingly, Applicants respectfully request that the objection to the Specification be withdrawn.

35 U.S.C. §112 Rejection

Claim 3 was rejected under 35 U.S.C. §112, 2nd paragraph. The Examiner asserts that the meaning and the scope of the term "nail plate" has not been set forth. This rejection is respectfully traversed.

According to MPEP § 2173.02, the test for definiteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Applicants submit that the recitation "nail plate" is sufficiently described in the specification such that a person skilled in the art would understand what the claimed invention is when the claims are read in light of the specification and the teachings of the prior art. Specifically, Applicants note that the phrase "nail plate" is described in lines 18-19 of page 2 and lines 5-6 of page 4 of the substitute specification. Furthermore, the "nail plate" is shown (indicated by reference character 7) in FIG. 1.

Even further, a search of the USPTO online patent and patent application publication database reveals that the phrase "nail plate" is used in numerous patents and patent application publications.

Thus, Applicants submit one ordinarily skilled in the art reviewing the original disclosure and pending claims would understand the instant invention and readily ascertain the scope of the invention. Therefore, Applicants submit the instant rejection is improper.

Accordingly, Applicants respectfully request that the rejection over claim 3 be withdrawn.

35 U.S.C. §103 Rejection

Claims 1-3 and 5-10 were rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Patent Application Publication No. 2004/0101649 issued to Thoma ("Thoma") or U.S. Patent No. 823,843 issued to Buyten ("Buyten") in view of U.S. Patent No. 6,696,167 issued to Sean *et al.* ("Sean"). Claim 4 was rejected under 35 U.S.C. §103(a) for being unpatentable over Thoma or Buyten in view of Sean, and further in view of U.S. Patent No. 5,275,862 issued to Ramadan *et al.* ("Ramadan"). These rejections are respectfully traversed.

Claims 1-3 and 5-10

The present invention relates to a building board for use as a ceiling or wall element. Independent claim 1 has been amended to recite, *inter alia*,

... a plurality of orientated strand boards (OSBs) which are disposed side by side and are bonded together in multiple layers, further comprising some interspaces filled with an insulating material and other interspaces devoid of the insulating material.

The applied references do not teach or suggest these features. More particularly, the applied references do not teach or suggest that some interspaces are filled with an insulating material while other interspaces are devoid of the insulating material.

The Examiner is of the opinion that Thoma and Buyten each show interspaces filled with air, and that air is an insulating material. While Applicants do not concede this characterization of the applied art, claim 1 has, nevertheless, been amended to clarify the invention by reciting that the building board comprises some interspaces filled with an insulating material and other interspaces devoid of the insulating material. In this regard, even assuming *arguendo* that air constitutes an insulating material, which Applicants do not concede, all of the interspaces of Thoma and Buyten are filled with air. None of the interspaces shown by Thoma and Buyten are devoid of air. Moreover, Sean does not disclose interspaces. Therefore, the applied references do not teach or suggest the combination of features recited in independent claim 1.

Claims 2, 3, and 7-10 depend from allowable claim 1, and are allowable at least for the reasons discussed above with respect to claim 1. Claims 5 and 6 have been canceled.

Accordingly, Applicants respectfully request that the rejection over claims 1-3 and 5-10 be withdrawn.

Claim 4

Claim 4 depends from allowable claim 1, and is allowable at least for the reasons discussed above with respect to claim 1. Moreover, Ramadan does not compensate for the deficiencies of Thoma, Buyten, and Sean with respect to claim 1. That is, Ramadan does not disclose interspaces. Therefore, no proper combination of the applied references teaches or suggests the combination of features recited in the claimed invention.

Furthermore, Applicants respectfully submit that there is no motivation to further modify either Thoma or Buyten as suggested in the Office Action. Ramadan discloses a multi-ply panel board with a shaped edge. The board comprises wood layers (col. 2, lines 23-28). An intermediate layer composed of cloth, glass fibers, or plastics is disposed between the wood layers (col. 2, lines 43-48). The edges of the board are sculpted to expose the intermediate layers as decorative stripes (col. 2, lines 49-53). That is, the edge of the board is beveled to show the alternate layers to give a different design to the strip along the beveled edge (col. 3, lines 22-26; and FIG. 3).

Neither Thoma nor Buyten has a beveled edge. Merely adding a plastic mat between layers of Thoma or Buyten, as suggested in the Office Action, would not achieve the decorative shaped/sculpted/beveled edge explicitly taught by Ramadan. As such, the motivation provided in the Office Action is inaccurate, and, therefore, inadequate to support a *prima facie* case of obviousness.

Accordingly, Applicants respectfully request that the rejection over claim 4 be withdrawn.

Other Matters

New claims 11-21 are added by this amendment and are believed to be patentably distinct from the applied art and in condition for allowance. For example, new independent claim 11 recites, *inter alia*, first interspaces filled with an insulating material and second interspaces are devoid of the insulating material. As discussed above, this is not taught or suggested by the applied art.

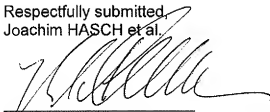
New independent claim 16 recites, *inter alia*, an outermost layer of first oriented strand boards disposed side by side and interspaces filled with insulating material in the outermost layer. This feature is not taught or suggested by the applied art.

New independent claim 20 recites, *inter alia*, at least one plastic mat structured and arranged to increase the sound-insulation and heat insulation disposed between two layers. As discussed above with respect to claim 4, there is no proper motivation to combine the teachings of Ramadan with either Thoma or Buyten. Moreover, the plastic mat of Ramadan is provided merely for aesthetic purposes, and is not structured and arranged to increase the sound-insulation and heat insulation of the board, as recited in new claim 21.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,
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